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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,944	07/25/2003	Mauricio Esguerra	1998P2056D	3227

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GERMANY

EXAMINER
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KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,944

Applicant(s)

ESGUERRA ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/756,530.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

DE 3,901,345 cited in the information disclosure statement filed 25 July 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

A copy of this document is not present in this application or in the parent application.

DE 2,811,277; DE 3,729,700; DE 975,757; DE 877,177 and FR 2,738,949 cited in the information disclosure statement filed 25 July 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

EP 393,599, cited in the information disclosure statement filed 25 July 2003 was considered with respect to the explanation given in the specification.

The disclosure is objected to because of the following informalities: The specification teaches the amendments of cement, water and ferromagnetic grains is in terms of parts, but it is

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unclear what the parts are based upon, weight, volume or moles and if it is based on the total parts of these three components or the total parts of the device composition. In addition, applicants need to update the status of the parent application. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 6 and 10-14. There is no teaching in the specification of the claimed frequency range. The specification teaches the device is an electromagnetic shield, a magnetic disk, a coil or a circuit. There is no teaching that the device is a shell for a magnetic disk, a coil or a circuit.

Claims 5, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite since it is unclear what the parts are based upon, weight, volume or moles and if it is based on the total parts of these three components or the total parts of the device composition. Claims 13 and 14 are indefinite since a magnetic disk and a circuit are not electromagnetic modules, in that they do not emit electromagnetic radiation. .

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 05-182811.

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The translation of this reference teaches an electromagnetic shield for frequencies in the range of 500 MHz to 1 GHz produced by forming ferromagnetic ferrite grains by sintering the precursor component and grinding the sintered material to form grains having a particle size in the range of 2-8 mm and mixing or embedding the grains in a cement matrix. The claimed process reads upon that taught.

Claims 1-4, 7, 11 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 92/08678.

This reference teaches the process for producing a magnetic device, which can be used as a shell for coils (pg. 20). The process is to mix or embed ferromagnetic particles having in a size in the range of 50-100 microns (pg. 15) in a cement matrix. The taught size range is greater than the domains of ferromagnetic materials. The ferromagnetic particles can be ferrite particles (pg. 8), which are known to be produced by sintering. The claimed process reads upon that taught.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/08678.

This reference teaches the process for producing a magnetic device, which can be used as a shell for coils (pg. 20). The process is to mix or embed ferromagnetic particles having in a size in the range of 2-40 microns or 50-100 microns (pg. 15) in a cement matrix. The taught range of 2-40 microns overlaps the range of claim 7 and the taught range of 50-100 microns encompasses

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the value of claim 8. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed process.

Claims 1-3 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,102,405 in view of U.S. patent 5,609,788.

GB 2,102,405 teaches producing a magnetic wall covering, which can be considered a magnetic device, by mixing ferromagnetic particles with plaster. The particles can be ferrite particles, which are known to be formed by sintering. This reference does not teach the particle size of the particles. U.S. patent 5,609,788 teaches a similar composition to that of GB 2,102,405. U.S. patent 5,609,788 teaches the particle size of the ferromagnetic particles in the wall covering composition should be greater than 0.01 micron. Therefore, one of ordinary skill in the art would have found it obvious to use particles having a size greater than 0.01 micron in the plaster of GB 2,102,405. This size range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The references suggest the claimed process.

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The subject matter of this claim is directed to the process for producing the device claimed in U.S. 6,696,638, the parent for this application.

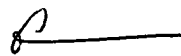
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (571) 272-1362.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
January 14, 2005

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700